

Remarks/Arguments:

Claims 1-19 are pending in the application.

Claims 1-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 2-16 of copending Application No. 10/714,144. The Office Action states that the claims are not patentably distinct because the subject matter sought in the instant application is fully encompassed by the claimed subject matter of 10/714,144. [emphasis added]

The Applicants respectfully traverse this provisional rejection as follows, beginning by providing two passages from the MPEP. As noted at MPEP 804 III,

"...a double patenting rejection must rely on a comparison with the claims in an issued or to be issued patent, whereas an obviousness rejection under 35 U.S.C. 102(e)/103(a) relies on a comparison with what is disclosed (whether or not claimed) in the same issued or to be issued patent." [emphasis added]

As further noted at MPEP 804 B. 1.,

"Any obviousness-type double patenting rejection should make clear:

- (A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent. [emphasis added]

The Applicants submit that the Office Action provides no reasons why a person would conclude that the present claims are an obvious variation of the 10/714,144 claims. A finding that the present claims are encompassed by the 10/714,144 claims is not sufficient to establish that they are obvious over these claims, because not all of the present claim elements are taught or suggested in the 10/714,144 claims. Specifically, the limitation stating that the backing structure is adhered to a paperboard structure is not disclosed or suggested in the 10/714,144 claims. Accordingly, a *prima facie* case of obviousness-type double patenting has not been presented, and the Applicants respectfully request that the provisional rejection be withdrawn.

Claims 1-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-16 of copending Application No. 10/820,549. The Office Action states that the claims are not patentably distinct because the subject matter sought in the instant application is fully encompassed by the claimed subject matter of 10/820,549.

The Applicants will file a terminal disclaimer to obviate these provisional rejections, once suitable claims are allowed in the present application.

Claims 1-2 are rejected under 35 U.S.C. § 103(a) as unpatentable over Benim et al., US 20030003249 A1 ("Benim"). The Applicants respectfully traverse the rejection, and point out that Benim does not disclose or suggest a paperboard layer adhered to the backing structure. Although Benim does describe the possibility of using paper, it is only mentioned as an

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alternative facing material 10 to which fibrous batt 30 is adhered. (See paragraphs [0002], [0025], and the Abstract.) As such, its analog in the present application would be the oriented polymer film layer, and it is in fact stated in the cited passages to be an alternative to film. But the present claims require BOTH a paperboard layer AND an oriented polymer film, and Benim nowhere discloses or suggests such a combination. Therefore, an essential element of the instant claims has not been provided, and a *prima facie* case of obviousness has not been presented.

Further, as the Examiner has noted, Benim does not specifically teach the structure of a scrim. The Examiner states that scrim structures are commonly nonwoven, and therefore she considers the melt blown polyolefin nonwoven "fabric" [the reference does not actually refer to it as a fabric] disclosed at paragraph [0022] to meet the limitation of a reinforcing scrim polymer. The Applicants respectfully submit that this is not valid logic. While it is true that some scrim structures are nonwoven, it is certainly NOT true that all nonwoven materials are reinforcing scrims, and the Office Action does not show evidence that the meltblown polyolefin referred to at [0022] would be suitable for use as such. As is stated repeatedly throughout the present application, and as emphasized in the title of the invention, tear resistance is important, and the reinforcing scrim is a large contributor to such strength. (See application, page 22 at lines 1-3.)

The USPTO describes scrims under class 442, subclass 1 as follows:

SCRIM (E.G., OPEN NET OR MESH, GAUZE, LOOSE OR OPEN WEAVE OR KNIT, ETC.):

This subclass is indented under the class definition. Subject matter wherein the fabric is a woven, nonwoven, or knitted fabric which is specifically described as having an open or loose configuration of strands or filamentary material. (1) Note. Scrim includes but is not limited to open net, mesh, gauze, loosely woven, or knitted fabrics. A characteristic of most scrims is the ability to see readily through the fabric from a distance.

The class definition referred to immediately above reads as follows:

This is the class for woven, knitted, nonwoven, or felt article claimed as a fabric, having structural integrity resulting from forced interassociation of fibers, filaments, or strands, the forced interassociation resulting from processes such as weaving, knitting, needling hydroentangling, chemical coating or impregnation, autogenous bonding (i.e., heat- and/or pressure-promoted welding or solvent bonding) or felting, but not articles such as paper, fiber-reinforced plastic matrix materials (FRP), or other fiber-reinforced materials wherein fibers are present only as a filler material. [emphasis added]

As is known in the art, and consistent with the above definitions, a scrim has "structural integrity", i.e., strength. Conversely, as is also known in the art, meltblown polyolefins are typically not of great strength. The Applicants provide herewith, for the Examiner's convenience, a printout of a World Wide Web page published by the College of Engineering at the University of Tennessee, titled "Melt Blown Technology." The Examiner's attention is drawn to page 7, Product Characteristics, point 2. It is stated that meltblown webs have "lower to moderate web strength." On page 9 under Major Process Modifications, it is stated that normal melt-blown webs have "limited physical strength", and that therefore they are sometimes adhered to spunbonded plies to provide physical strength. The Applicants note that spunbonded products, which are stronger than meltblown products, are mentioned as suitable scrims in the present application. (See page 17, lines 2-11) Finally, page 11 of Melt Blown Technology, second full paragraph, states that "With limited exceptions such as some wipes,

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melt-blown products are not designed to function as fabrics. They are generally manufactured in sheet form but lack the physical strength of conventional woven or nonwoven fabrics." [Emphasis added] In sum, all available evidence indicates that the meltblown polyolefin described by Benim cannot be a scrim. Rather, it is clear that Benim uses the meltblown material for insulation, without ever considering strength, tear resistance, or any similar concept.

Benim does not disclose or suggest the use of a scrim at all, and therefore this reference does not render the present claims obvious. Benim does not suggest employing ANY material to improve tear resistance, tensile strength, or indeed any other strength-related property. He is interested in providing insulation, not strength, and the reader of Benim would never be led to consider replacing the carefully chosen insulation layers that he describes (thermal resistance in the range of 0.05 to 0.5 CLO; see Benim claim 1) with a scrim designed for tear resistance but having little insulating value. Tear resistance is not even an issue for Benim.

The Examiner will no doubt appreciate that a material that is optimized for tear resistance is unlikely to be optimized for insulation value, and *vice versa*. The two functions are unrelated. As noted above, scrims have a relatively open structure and often are made of relatively coarse fibers bonded together; they are designed for strength and not insulating value, and would typically not be suitable for use as insulation layers. Conversely, insulation layers are typically made of relatively fine, fluffy materials without any particular regard for how physically strong or tear resistant they might be. Accordingly, disclosing the use of an insulation layer does not lead the person of skill in the art to consider using a scrim. In fact, the use of a typical scrim in place of Benim's insulation batt would render his invention unsuitable for its intended purpose, because it would not provide sufficient insulating properties.

As noted in the MPEP at 2143.01 V:

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

Thus, there would be no motivation to modify Benim by using a scrim instead of an insulating batt.

In sum, a skilled artisan reading Benim learns only that a material of good insulating value is suitable for making an insulating label for containers. The Applicants urge that a fair reading of Benim provides neither a disclosure of, nor a motivation to use, a reinforcing scrim polymer layer. Therefore a *prima facie* case of obviousness has not been presented. For all of the above reasons, the Applicants respectfully request reconsideration and allowance of claims 1-2. The Applicants note that claims 3-19 have not been rejected as obvious or anticipated, and therefore understand that these claims will be allowable once the issues relating to obviousness-type double patenting have been resolved. The Applicants request early notification if this is not the case.

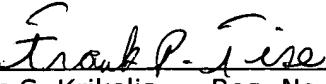
Conclusion

For the reasons recited above, the Applicants submit that claims 1-19 are in condition for allowance, and requests reconsideration and early notification of the same. The Applicants

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invite the Examiner to contact his undersigned representative, Frank Tise, if it is believed that such contact may expedite examination of the application.

Respectfully submitted,



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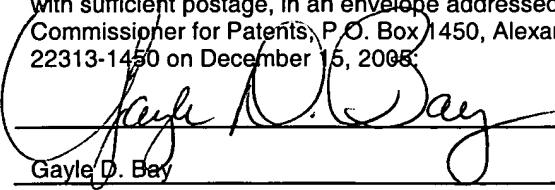
Attachments: Melt Blown Technology (13 pages)

Dated: December 15, 2005

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Gayle D. Bay